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REMARKS

Upon entry of the foregoing amendments, claims 21-41, 43-68, 70-95, 97-122, 124-149, 151-176 and 178-182 will be pending in the application. Claims 10-11, 18, 20, 42, 69, 96, 123, 150 and 177, drawn to non-elected subject matter, are herein canceled without prejudice or disclaimer and Applicants reserve the right to pursue the subject matter of these claims in related applications.

Accordingly, no new matter has been added.

Provisional Election

The Examiner has required an election under 35 U.S.C. § 121 of one of Groups I-III, alleging that the newly entered claims read on different embodiments.

In response, Applicants provisionally elect, *with traverse*, the subject matter of Group I represented by claims 21-41, 43-46, 48-68, 70-73, 75-95, 97-100, 102-122, 124-128, 130-149, 151-154, 156-176 and 178-181, drawn to polynucleotides of the invention, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement. As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

> Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made.

Applicants submit that a search of the subject of Group I would provide useful information for the sequences of the other Groups. For example, a search of claims to a polynucleotide, as designated by Group I, would clearly overlap with a search of the hybridization techniques using the polynucleotides, as represented by Group III. Therefore, the search and examination of at least Groups I and III, together, if not all of the groups, would not entail a serious burden.

Accordingly, in view of M.P.E.P. § 803, the claims of all of Groups I-III should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement be reconsidered and withdrawn, and that the instant claims be examined in one application.

Further, although not acquiescing to the restriction requirement, Applicants nevertheless note that the claims of Group I and the claims of Group III are related as between a product and a process for using the product. Moreover, the process claims of Group III either depend from or otherwise include all of the limitations of the product claims of Group I. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), if an elected product claim is found allowable, "withdrawn process claims which depend from or otherwise include all of the limitations of the allowable product claim will be rejoined." M.P.E.P. § 821.04. Accordingly,

Applicants respectfully request that if any of the claims of Group I, *i.e.*, claims 21-41, 43-46, 48-68, 70-73, 75-95, 97-100, 102-122, 124-128, 130-149, 151-154, 156-176 and 178-181, are found allowable, then the process claims of Group III be rejoined and examined for patentability.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. Applicants believe that this application is in condition for substantive examination. If in the opinion of the Examiner, a telephone conference would expedite prosecution, the undersigned can be reached at the telephone number indicated below.

If there are any fees due in connection with the filing of this paper, please charge the fees to Deposit Account No. 08-3425.

Respectfully submitted,

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